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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,326	05/25/2001	James Arthur Davis	16,234	5265

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KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENAH, WI 54956

EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/04/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/866,326

Applicant(s)

DAVIS ET AL.

Examiner

Karin M. Reichle

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,8-12,15,17,32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,13,14,16,18-31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 3, 4, 8-12, 15, 17 and 32, and now new claim 34, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.
2. The abstract of the disclosure is objected to because legal terminology, i.e. "means", should be avoided. Correction is required. See MPEP § 608.01(b).
3. Contrary to Applicant's remarks no proposed drawing changes accompanied the 3-17-03 response.
4. The drawings are objected to because where are 37 and 39 as now described on page 11, first full paragraph? Also the valve 28 shown in Figure 3 where the bellows are inflated and the description in the paragraph bridging pages 11-12 is inconsistent, i.e. the valve 28 as shown is open upon inflation and closed upon deflation of the bellows whereas it should be closed during inflation since it is described as a one way outlet valve. In Figure 5, 32 does not appear to denote a connection means. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims 1-2, 5-7, 13-14, 16, 18-31 and 33, i.e. topsheet, backsheet, connection means permitting the

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connection of a pumping means, i.e. the bellows, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d) and 1302.01, e.g. where in the claims is desiccant on the inside of the valving means claimed? 2) On page 5, line 12, since STARRET is a trademark, the word “-type” should be avoided, i.e. the tester either originates from the source designated by the trademark or not. 3) Also as discussed supra, the description and the Figures are inconsistent, i.e. see discussion of elements 28 and 32 supra. 4) In the paragraph bridging pages 12-13, the terminology, i.e. “In the claims...structures.” should be avoided, i.e. such describes legal interpretation which is determined by the courts and the legislature. The paragraph set forth in the 3-17-03 response was not entered because it did not comply with 37 CFR 1.121, i.e. the marked up copy and the clean copy do not agree. Appropriate correction is required.

7. The use of the terminology “valving means”, “connection means which...means”, “pumping means”, “the valve...means allows...article”, “any manual...means...article”, distribution means”, “distribution means facilitates ...wearer.”, “manual or mechanically assisted means” in the

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claims is not considered to invoke 35 USC 112, sixth paragraph, since such either is not presented in proper "means for" format and/or is claimed with sufficient specific structure of the means in the same claim to perform the claimed function.

8. Applicant's remarks on pages 4-7 with regard to the informalities have been noted but are either deemed moot in that the issue has not been reraised or is deemed nonresponsive for the reasons set forth supra. It is noted that Applicant's remarks with regard to element 28 are narrower than the description which does not describe Figure 3 as argued. Also, Figure 5 shows 32 but such is not connected to the pump means, i.e bellows. Furthermore, the legal interpretation of the "mean for" format claim scope must be determined during prosecution in order to determine the scope of the claims.

9. Claim 14 would be in better form if on line 1, after "The", --absorbent-- were inserted.

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-2, 5-7, 13-14, 16, 18-31 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Lau et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor

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of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See Figures 4 and 5 of Lau, i.e. absorbent article or personal care product having a topsheet and backsheet 20, see also col. 3, lines 44-50, valving means or distribution means, i.e. 25 is valve, connection leading thereto is piping, juncture between piping and 21 is connection means, pumping means, i.e bellows 21, valves 24. Also see abstract, col. 1, lines 56-67, col. 2, lines 10-13, col. 5, lines 7-14, 25-38, col. 6, lines 20-50 and claims. Attention is also directed to Figures 4 and 5 of the instant application.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-2, 5-6, 14, 16, 20-31 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6, and thus also claim 5 by dependence therefrom, of U.S. Patent No. 6,454,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed after the patent the one way *In re Vogel* test applies, i.e. are the claims of the application obvious in view of the claims of the patent, and the answer to the test is yes. Specifically the claims of both the application and patent require a "personal care product" as interpreted in light of the descriptions, see portions of patent cited *supra*, the patent claims require distribution means including piping conveying air from a bellows, i.e obviously the bellows is a self contained manual assisted pump and there is a structure between the piping and bellows to provide the conveying which is a "connection" therebetween and both the claims of the application and patent require distribution of air or air exchange between the wearer's skin and the product(In other words, the application claims are merely broader, i.e generic to, than the patent claims. Once the applicant has received a patent for a species or a more specific embodiment he is not entitled to a patent for the generic or broader invention. This is because the specific anticipates the broader. The patented claims anticipate the application claims. See *In re Goodman*, *supra*).

14. Claims 1-2, 5-6, 14, 16, 20-31 and 33 are directed to an invention not patentably distinct from claims 5-6 of commonly assigned 6,454,749. Specifically, see preceding double patenting

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rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 6,454,749, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78© and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows other ventilated garments or garments which have air passed into at least a portion thereof. Attention is especially drawn to col. 9, lines 37-56 of the '424 patent.

16. Applicant's remarks bridging pages 7-8 with regard to the prior art have been considered but are deemed nonpersuasive because 1) Lau does teach a bellows, see element 21 in Figures 4

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and 5 thereof which as stated by Applicant is a pump means and a connection means between such and a valving means, i.e the juncture of 21 with the piping leading to valving 25, and 2)

Applicant has now set forth that claims 1, 5, 14, 20-29 and 33 don't even require a pump.

Therefore Applicant's arguments are considered narrower than the claim language. It is noted that Applicant did not address, i.e traverse, the double patenting rejections nor the rejection set forth in paragraph 14 supra, i.e is presumed such is agreed with.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The amendments to the specification and claims 6, and 18-19 necessitated any new grounds of rejection. It is noted that the amendments to the claims affected the interpretation of

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claim 1 and thereby the claims dependent therefrom, i.e. as set forth by Applicant the pump is not part of claim 1.

18. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFAX number is 703-872-9302.

KMR

May 21, 2003

K.M. Reichle
KAPIN ZEPHRA
PATENT EXAMINER